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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,066	09/17/2003	Pankaj Patel	00568-286923	5494

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EXAMINER

EDEL, JOHN B

ART UNIT	PAPER NUMBER
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1731

MAIL DATE	DELIVERY MODE
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06/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/665,066	Applicant(s) PATEL ET AL.	
	Examiner John B. Edel	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 19-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

The terminal disclaimer filed on April 4, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of United States Patents 6,997,190, 6,976,493, and 6,929,013 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102/ 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The current application contains product by process claims. Such claims are handled as laid out in MPEP section 2113.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted) ...

"The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference

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between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983) ...

"[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

MPEP section 2113

Claim 1-20, 22-27, 29-32, 34-37, and 39-42 are rejected under either 35 U.S.C. 102(b) or 35 U.S.C. 103(a) as being anticipated/ obvious over by United States Patent No. 5,878,753 to Peterson et al. ("Peterson").

As for claim 1, Peterson teaches:

- A wrapping material substrate [col. 1 lines 5-15],
- A plurality of bands [figures 2-4], and
- A pattern [figure 2].

The step, depositing layers of a coating formulation in a pattern on the substrate, is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with depositing layers of a coating formulation in a pattern on the substrate in the specification. The method of application, spraying, is deemed

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not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with spraying in the specification.

As for claim 2, the wrapping is adapted to be useful in a reduced ignition propensity cigarette.

As for claim 3, the cigarette has the transverse bands claimed [figure 2].

As for claim 4, the coatings are applied in predetermined amounts [col. 7 lines 20-45].

As for claim 5, The method of applying coating online is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with applying coating on line.

As for claim 6, Peterson teaches:

- A wrapping material substrate [col. 1 lines 5-15],
- A plurality of bands [figures 2-4], and
- A pattern [figure 2].

The step, depositing layers of a coating formulation in a pattern on the substrate, is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with depositing layers of a coating formulation in a pattern on the substrate in the specification. The method of application, applying by ink jet, is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with applying by ink jet in the specification.

As for claim 7, the wrapping material of Peterson is adapted to be useful in manufacturing reduced ignition proclivity cigarettes.

As for claim 8, the pattern comprises transverse bands of coating with longitudinal widths spaced along the longitudinal length [figures 2-4].

As for claim 9, Peterson teaches applying in predetermined amounts [col. 7 lines 20-45].

As for claim 10, The method of applying coating online is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with applying coating on line.

As for claim 11, Peterson teaches:

- A wrapping material substrate [col. 1 lines 5-15],
- A plurality of bands [figures 2-4], and
- A pattern [figure 2].
- Multiple layers on top of one another which reduce the porosity of the underlying paper [col. 2 line 55 to col. 3 line 15; col. 7 lines 20-45]

The step, depositing layers of a coating formulation in a pattern on the substrate, is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with depositing layers of a coating formulation in a pattern on the substrate in the specification. The method of application, spraying, is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with spraying in the specification.

As for claim 12, see citations in and reasoning from the treatment of claims 6 and 11.

As for claim 19, the bands are on an outside surface of the wrapping paper [figure 2].

As for claim 20, the performance characteristics of the cigarette are altered [col. 2 line 40 to col. 3 line 15].

As for claims 22-25, 29-30, 34-35, and 39-40, several descriptions of the formulation deposited in a pattern are claimed. These further descriptions of the step, depositing a coating formulation, are deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with the steps in the specification.

As for claims 26, 31, 36, and 41, Peterson teaches a solid coating on the substrate [figures 3 and 4]. If any non-obvious structural feature is associated with the depositing as claimed Applicant should point out that feature and why it is necessarily present in the claim.

As for claims 27, 32, 37, and 42, the step, of offline application, is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with the step in the specification.

Claims **21, 28, 33, and 38** are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson as applied to claims 1, 6, 11, and 12 above.

As for claims 21, 28, 33, and 38, at the time of the invention, it would have been obvious to a person having ordinary skill in the art of cigarette paper manufacture to use

burn control agents in the invention of Peterson because Peterson teaches burn control agents being used in association with reduced porosity bands [col. 2 lines 5-15].

In the event any differences can be shown for the product of the product-by-process claim(s) 1-12 and 19-32, as opposed to the product taught by the reference Peterson, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of showing of unexpected results; see also *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Response to Arguments

Applicant's arguments with respect to claims 1-12 and 19-42 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Edel whose telephone number is (571) 272-4804. The examiner can normally be reached on 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBE


STEVEN P. GRIFFIN
PRIMARY EXAMINER